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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,391	10/07/2004	Jonathon Leigh Napper	NPW012US	6473
24011 7590 12/13/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER CHOJNACKI, MELLISSA M	
			ART UNIT 2164	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/510,391

Applicant(s)

NAPPER ET AL.

Examiner

Mellissa M. Chojnacki

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

## DETAILED ACTION

### *Specification*

The specification is object too because:

1. The abstract contains the phrase "are provided". The abstract should not contain "are provided". Examiner suggests just deleting the phrase. Correction is required.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopresti et al. (U.S. Patent No. 5,832,474).

As to claim 1, Lopresti et al. teaches a method of improving accuracy in searching digital ink stored in a database accessible by a processing system (See abstract; column 3, lines 16-28), the method comprising:

receiving, as digital ink in the processing system the search input query having a specialized textual or graphical format (See column 2, lines 43-59; column 3, lines 16-33);

determining a specialized format of digital ink (See column 3, lines 16-28, where "patterns" is read on "format");

selecting a digital ink searching algorithm within the processing system which is specifically based on the specialized format of digital ink determined by the processing system (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and,

searching the digital ink stored in a database for a match to the search input query by utilising the selected digital ink searching algorithm (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and

returning any matches to the search input query as a search result (See column 3, lines 16-28).

As to claim 2, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on the digital ink to be searched (See column 3, lines 16-28).

As to claim 3, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on the search input query (See column 3, lines 16-28).

As to claim 4, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on information contained in a document associated with the digital ink to be searched (See column 3, lines 16-28).

As to claim 5, Lopresti et al. teaches wherein the specialized format of digital ink is determined manually, by a user selecting the specialized format of digital ink (See column 3, lines 16-28).

As to claim 6, Lopresti et al. teaches wherein the specialized format of digital ink is determined manually, by a parameter associated with the system processing the digital ink (See column 3, lines 16-28, where "spatial and temporal components" is read on "parameter").

As to claim 7, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on a font contained in the document associated with the digital ink to be searched (See column 3, lines 16-28; column 8, lines 13-61).

As to claim 8, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document label or document setting associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 9, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document field label associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 10, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document field attribute associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 11, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on an analysis of the characteristics of the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 12, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a written language or script of the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 13, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a written character set of the digital ink to be searched (See

column 8, lines 13-61; column 11, lines 61-67).

As to claim 14, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on differentiating written text from drawings in the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 15, Lopresti et al. teaches wherein the search input query is of a type from the group of: textual; numerical; alphanumeric; pictorial; or graphical (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 16, Lopresti et al. teaches wherein an indicating label of the specialized format of digital ink is stored with the digital ink (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 17, Lopresti et al. teaches a system for improving accuracy in searching digital ink (See abstract), the system comprising: (1) an input device to receive a search input query (See column 3, lines 16-33); (2) a storage device to store the searchable digital ink (See column 4, lines 4-15); (3) at least one processor in communication with the storage device (See column 4, lines 4-30), the at least one processor adapted to: (A) determine a specialized format of digital ink (See column 3, lines 16-28, where "patterns" is read on "format"); (B) select a digital ink searching algorithm based on the determined specialized format of digital ink (See column 2, lines

60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and, (C) search the digital ink for matches to the search input query by utilising the selected digital ink searching algorithm (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and, (4) an output device to display one or more search results (See column 7, lines 1-6).

As to claim 18, Lopresti et al. teaches wherein the input device is a pen-based input device (See abstract; column 1, lines 12-16).

As to claim 19, Lopresti et al. teaches wherein the input device is a keyboard or keypad (See column 1, lines 44-45).

As to claim 20, Lopresti et al. teaches wherein the output device is a printer or a visual display (See column 7, lines 1-6).

As to claim 21, Lopresti et al. teaches wherein the digital ink is associated with one or more of a document label, a document setting, a document field label or a document field attribute, and the specialized format of digital ink is determined from one or more of the document label, the document setting, the document field label or the document field attribute (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).



As to claim 22, Lopresti et al. teaches wherein the at least one processor determines the specialized format of digital ink based on user input to the input device (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 23, Lopresti et al. teaches the system as claimed in claim 17, the at least one processor adapted to perform the method of any one of the claims 1 to 16 (See column 4, lines 16-30).

### ***Response to Arguments***

5. Applicant's arguments filed on 09-September -2007, with respect to the rejected claims 1-23 have been fully considered but they are not found to be persuasive:

In response to applicants' arguments regarding "Lopresti merely discloses searching a database of user-drawn annotations for matches to temporal and spatial patterns of search queries (see col. 3. lines 16-28) and does not teach or suggest: determining specific searching algorithms searching specialized textual and graphic formats of input digital ink search queries, as is requires by the claimed invention", the arguments have been fully considered but are not found to be persuasive, because Lopresti et al. disclosed a document search and retrieval system (See abstract; column 3, lines 3-28). The claims as written do not disclose what is a specialized format, text or graphic formats, therefore these terms are very board and Lopresti et al. read on them. For example annotation can be searched in Lopresti et al. as part of a document retrieval by capturing the "ink" stokes of the annotation and annotations are a textual

format (See column 2, lines 19-35). Lopresti et al. also uses several algorithms in order to search and match document retrieval (See column 2, lines 60-67) and again the claim language disclose a generic search algorithm. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mellissa M. Chojnacki whose telephone number is (571) 272-4076. The examiner can normally be reached on 9:00am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 5, 2007  
Mmc

  
**SAM RIMELL**  
PRIMARY EXAMINER